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**Response**  
Serial No.: 09/888,943  
Confirmation No.: 9282  
Filed: 25 June 2001  
For: RESPIRATOR VALVE

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### **Office Action Inconsistencies**

The Office Action mailed August 9, 2006 appears to contain inconsistencies.

First, the "Summary" rejects claims 15-20, 23-34, and 38-50 while the "Detailed Action" does not indicate how or why claims 46 and 47 are rejected. For purposes of this response, Applicants assume that claims 46 and 47 are not rejected.

Second, the "Summary" indicates that claims 28-35 and 39-45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Japuntich et al. However, below such statement, independent claim 38 is addressed as if rejected under 35 U.S.C. § 102(b). For purposes of this response, Applicants assume that claim 38 is rejected under § 102.

### **Allowable Claims**

Applicants note that claims 21, 22, 36, 37, 46, and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

### **Obviousness-Type Double Patenting Rejection**

Claims 15-18, 28, 38, and 48-50 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-16 and 26 of Mittlestadt et al. (U.S. Patent No. 6,883,518).

Claims 15, 17-20, and 23-27 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-10, 12, and 18 of Mittlestadt et al. (U.S. Patent No. 6,883,518) in view of Braun (U.S. Patent No. 4,934,362).

Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

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**The 35 U.S.C. §102 Rejection**

Claims 28-35 and 38-45 were rejected under 35 U.S.C. §102(b) as being anticipated by Japuntich et al. (U.S. Patent No. 5,509,436). This rejection is respectfully traversed.

For a claim to be anticipated under 35 U.S.C. § 102(b), each and every element of the claim must be found in a single prior art reference (M.P.E.P. §2131). Applicants respectfully assert that Japuntich et al. fail to teach each and every element of the rejected claims.

Independent claims 28 and 38 describe respirators that include a unidirectional valve including a valve flap, wherein the valve flap has a side profile including a curvature from the first end to the second end when the valve flap is not attached to the valve body (claim 28) or when the valve flap is not attached to the face mask (claim 38). In addition, the curvature, or at least a portion of the curvature, of the valve flap is at least partially flattened when the valve flap seals the valve opening (claim 28) or seals the opening in the face mask (claim 38). That is, claims 28 and 38 recite a valve flap that is designed with a curvature that is reshaped into a partially flattened shape when in contact with the valve seat.

It is asserted at page 2 of the Office Action that "Japuntich discloses a flexible flap preferably assum[ing] a flat configuration" and that the presence of the word "preferably" means that "the valve flap taught in Japuntich can have a valve flap with a side profile having a curvature when the valve flap is not installed to a valve body or a face mask, wherein the curvature, or a portion of the curvature, is at least partially flattened when the valve flap seals the opening and does not have to assume a flat configuration." The Examiner further asserted that "Japuntich discloses a flexible flap [which] may be cut from a flat sheet of material" and that the phrase "may be" means that "it is not necessary for the material to be flat but could be curved." See, Office Action, p. 2 (August 9, 2006) (emphasis added). Applicants disagree.

This rejection is based on assertions that are not supported by the reference itself, i.e., that the valve flaps of Japuntich et al. could have a curvature from the first end to the second end when not attached to the valve body or to the face mask, that the curvature of the valve flap, or a portion thereof, could be at least partially flattened when the valve flap seals the opening, and

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that the flexible flap could be cut from a curved sheet of material. The Examiner has not identified where or how those assertions are supported by the reference itself.

If it is the Examiner's intent to rely on inherent characteristics of the disclosure of Japuntich et al., then it should be noted that the requirements for a proper § 102 rejection based on inherent characteristics of the valve flaps of Japuntich et al. have not been met. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112(IV), (emphasis in original).

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." MPEP § 2112(IV), p. 2100-47, 8<sup>th</sup> Ed., Rev. 5 (Aug. 2006) (*citing In re Roberison*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112(IV), p. 2100-48, 8<sup>th</sup> Ed., Rev. 5 (Aug. 2006) (*citing Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Intcr. 1990)) (emphasis in original).

Applicants submit that the Examiner has failed to show that the valve flaps of Japuntich et al. necessarily have the characteristics recited in independent claims 28 and 38.

In contrast to the invention recited in claims 28 and 38, Japuntich et al. teach valve flaps that do not have an inherent curvature that is at least partially flattened when the valve flap seals an opening. Rather, Japuntich et al. teach valve flaps that are themselves flat, and that are deformed when secured to, e.g., a valve seat and outside forces are applied thereto:

Flexible flap 24 preferably is made from a material that is capable of displaying A bias toward seal ridge 30 when the flexible flap 24 is secured to the valve seat 26 at surface 40. The flexible flap preferably assumes a flat configuration where no forces are applied and is elastomeric and is resistant to permanent set and creep. Japuntich et al., column 7, lines 27-34.

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Flexible flap 24 may be cut from a flat sheet of material having a generally uniform thickness.

Japuntich et al., column 7, lines 55-56.

Seal ridge 30 has a concave curvature . . . [that] corresponds to the deformation curve displayed by the flexible flap when it is secured as a cantilever beam.

Japuntich et al., column 6, lines 14-17 (emphasis added).

In other words, Japuntich et al. teach valve flaps that are flat when not secured to a valve seat, and which display a deformation curve when in a closed position resting on the seal ridge (Japuntich et al., col. 6, lines 12-13). Japuntich et al. do not teach valve flaps with a side profile having a curvature when the valve flap is not attached to a valve body or face mask, wherein the curvature, or a portion of the curvature, is at least partially flattened when the valve flap seals the opening, as asserted in support of this rejection.

Additionally, for at least the reason that Japuntich et al. fail to teach each and every aspect of independent claims 28 and 38, Japuntich et al. also fail to teach each and every aspect of claims 28-35 and 38-45, dependent directly or ultimately thereto.

For at least the reasons stated above, Applicants submit that claims 28-35 and 38-45 are not anticipated by Japuntich et al. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

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**Summary**

It is respectfully submitted that pending claims 15-50 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted  
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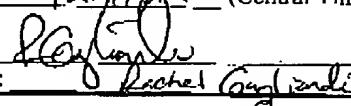
Date

9 NOV. 2006

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**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 9th day of November, 2006, at 12:45pm (Central Time).

By: 

Name: Rachel Langland